

REMARKS

The Final Office Action mailed December 1, 2006, has been received and reviewed. Claims 1, 3 through 12, 14, 15, 17 through 19, and 21 through 24 are currently pending in the application. Claims 1, 3 through 12, 14, 15, 17 through 19, and 21 through 24 stand rejected. Applicants propose to amend claims 1, 7, 8, 15, 19, 23, and 24, and respectfully request reconsideration of the application as proposed to be amended herein.

35 U.S.C. § 112 Claim Rejections

Applicants thank the Examiner for withdrawal of the 35 U.S.C. § 112 rejections.

35 U.S.C. § 102 Rejections

Applicants thank the Examiner for withdrawal of the 35 U.S.C. § 102 rejections based on Suzuki *et al.* (U.S. Patent No. 4,579,591), Momose *et al.* (U.S. Patent 6,749,675), and European Patent 0 499 425.

Anticipation Rejection Based on U.S. Patent Publication No. 2004/0206274 to Kruckel

Claims 1, 4 through 6, 15, and 18 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kruckel (U.S. Patent Publication No. 2004/0206274). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With respect to inherency, M.P.E.P. § 2112 provides:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) . . . 'To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill . . . ' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1991).

Regarding independent claims 1 and 15, Applicants assert that Kruckel does not describe, either expressly or inherently, each and every element recited in the claims to anticipate the claimed invention under 35 U.S.C. § 102. Contrary to the Examiner's assertion, Kruckel does not describe "wherein the at least one cationic polymer is capable of reacting with a component of an inkjet ink" as recited in amended claims 1 and 15. Kruckel "relates to an aqueous dispersion useful for internal sizing or surface sizing in the production of paper" *Abstract*. There is no disclosure that the dispersion of Kruckel would include cationic polymers having the structural and functional capacity to react with a component of an inkjet ink. Without extrinsic evidence, it is impossible for Kruckel to inherently disclose at least one cationic polymer capable of reacting with a component of an inkjet ink. No such extrinsic evidence has been provided. Therefore, for at least this reason, independent claims 1 and 15 are novel.

Claims 4 through 6 and 18 are novel for at least the reason of depending from novel base claims.

Anticipation Rejection Based on U.S. Patent No. 4,176,107 to Buckman *et al.*

Claims 1, 5, and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Buckman *et al.* (U.S. Patent No. 4,176,107) (hereinafter "Buckman"). Applicants respectfully traverse this rejection, as hereinafter set forth.

Regarding independent claims 1 and 15, Applicants assert that Buckman does not describe, either expressly or inherently, each and every element recited in the claims to anticipate the claimed invention under 35 U.S.C. § 102. Contrary to the Examiner's assertion, Buckman does not describe "wherein the at least one cationic polymer is capable of reacting with a component of an inkjet ink" as recited in amended claims 1 and 15. There is no disclosure that the dispersion of Buckman would include cationic polymers having the structural and functional capacity to react with a component of an inkjet ink. Without extrinsic evidence, it is impossible for Buckman to inherently disclose at least one cationic polymer capable of reacting with a component of an inkjet ink. No such extrinsic evidence has been provided. Therefore, for at least this reason, independent claims 1 and 15 are novel.

Claim 5 is novel for at least the reason of depending from a novel base claim.

35 U.S.C. § 103(a) Obviousness Rejections

Applicants thank the Examiner for withdrawal of the 35 U.S.C. § 103 rejection based on Ma *et al.* (U.S. Patent Publication 2004/0063808) (hereinafter “Ma”) in view of Tomioka *et al.* (U.S. Patent Publication 2003/0103121).

Obviousness Rejection Based on Ma in view of U.S. Patent No. 6,610,129 to Sader *et al.*

Claims 1, 3 through 10, 12, 14, 15, 17 through 19, and 21 through 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ma in view of Sader *et al.* (U.S. Patent No. 6,610,129) (hereinafter “Sader”). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Regarding independent claims 1, 15, and 19, Applicants assert that Ma and Sader, even if combined, do not teach or suggest all of the claim limitations to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Ma does not teach or suggest “wherein the at least one cationic polymer comprises at least one of polyallylamine or a quaternized polyamine” as recited in amended claims 1, 15, and 19. Sader does not cure this failing. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established for amended claims 1, 15, and 19.

Claims 3 through 10, 17, and 18 are non-obvious for at least the reason of depending from non-obvious base claims.

Regarding independent claim 12 and 19, Applicants assert that the Final Rejection is improper as the Examiner has not met the initial burden of establishing a *prima facie* case of

obviousness. The Examiner has not specified why one of skill in the art would select the claimed species from the Sader phosphate ester genus. Applicants respectfully request withdrawal of the finality of the Office Action.

The Examiner has a special burden when trying to assert the obviousness of a species based upon a genus. “In light of the findings made relating to the three *Graham* factors, Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus.” *M.P.E.P.* § 2144.08(II)(A)(4). “[T]he mere possibility that one of the esters or the active methylene group-containing compounds... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious ‘unless the prior art suggested the desirability of [such a] modification’ or replacement.” *M.P.E.P.* § 2144.08(II)(A). The Examiner alleges that Sader discloses a phosphate ester of the formula $(RE_x)_yPO_{(4-y)}H_{(3-y)}$ where R is a hydrocarbon group of at least 8 carbons, E is an ethoxy group, x is greater than 0, and y is 1-3. *Office Action mailed December 1, 2006, page 6*. The Examiner relies on this for asserting that claims 12 and 19 are obvious. Claim 12 recites “wherein the at least one phosphate ester surfactant is selected from the group consisting of a nonylphenol ethoxylate phosphate ester, a salt of a nonylphenol ethoxylate phosphate ester, a phosphated nonylphenoxy polyethoxy ethanol, and a salt of ethyl-hexanol ethoxylated phosphate ester.” Claim 19 recites that “the at least one phosphate ester surfactant is selected from the group consisting of a nonylphenol ethoxylate phosphate ester, a salt of a nonylphenol ethoxylate phosphate ester, a phosphated nonylphenoxy polyethoxy ethanol, organo phosphate, and a salt of ethyl-hexanol ethoxylated phosphate ester.” The Examiner has not specified why one of skill in the art would select the claimed species from the Sader phosphate ester genus. Therefore, the final rejection of claims 12 and 19 is improper.

Additionally, one of skill in the art would not select the claimed phosphate ester species from the genus of Sader. The express teachings of Sader limit the R to branched, unbranched, or perfluorinated hydrocarbon. *Column 6, lines 58-59*. Sader does not disclose every possible hydrocarbon containing group. Rather, Sader discloses hydrogen and carbon only, with the possibility of fluorine. If alcohol groups were contemplated, then the R

group would list more possibilities than just fluorine. Therefore, Sader would not teach one of skill in the art to select the claimed species. Additionally, if the Examiner considers the R of the Sader formula to encompass any and all functional groups that have hydrocarbons, then the formula possibilities become almost infinite. Therefore, under that interpretations, Sader still does not teach one of skill in the art to select the claimed species. Therefore, for at least these reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established for claims 12 and 19.

Claims 14 and 21 through 24 are non-obvious for at least the reason of depending from non-obvious base claims.

Obviousness Rejection Based on Ma in view of Sader, as applied to claims 1, 3 through 10, 12, 14, 15, 17 through 19, and 21 through 24 above, and further in view of U.S. Patent Publication No. 2005/0155516 to Hermansky

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ma in view of Sader, as applied to claims 1, 3 through 10, 12, 14, 15, 17 through 19, and 21 through 24 above, and further in view of Hermansky (U.S. Patent Publication No. 2005/0155516). Applicants respectfully traverse this rejection, as hereinafter set forth.

Hermansky does not overcome the shortcomings of Ma and Sader discussed above. Claim 11 depends from claim 1 and, as such, adopts the recitations of claim 1 via dependency therefrom. The non-obviousness of claim 1 also precludes the obviousness rejection of the dependent claim. Thus, claim 11 is non-obvious.

ENTRY OF AMENDMENTS

The proposed amendments to claims 1, 7, 8, 15, 19, 23, and 24 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1, 3 through 12, 14, 15, 17 through 19, and 21 through 24 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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Date: February 1, 2007
ERC:KAE/sfc:tlp